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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,538	09/13/2001	Seiichi Tagawa	6404-03WOUS	7147

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,538

Applicant(s)

TAGAWA ET AL.

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Rejections Repeated

1. The 35 U.S.C. 103(a) rejection of claims 8-9 over Sievers et al. in view of Kurashiki has been repeated for the reasons previously made in response 1/28/2004.

Response to Arguments

2. Applicant's arguments filed 6/7/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Kurashiki does not teach or suggest that the organosilane compound is used as a non-slip agent, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that Kurashiki fails to teach a surface roughness of at least one of the metal surfaces adhering to the polymer elastic body of 5 to 50 umRz, Sievers teaches the surface roughness in at least one of a metal surface adhering to the polymer elastic body in the hub and a metal surface adhering to the polymer elastic body in the inertia mass body is 5 micrometers Rz (col. 2 lines 27-28 discloses 260 RMS as the measurement of

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surface roughness which is measured in microinches however applicant claims Rz value in micronmeters therefore, in {col. 5 lines 57-59} Sievers et al. teaches that RMS is a 11% higher value than a Ra value which also is a Rz measurement in micronmeters so when RMS is converted to Rz the value is about 5 micronmeters). Kurashiki is used as secondary reference to teach an organosilane provided between a metal and vulcanized and molded rubber for the purpose of being used under a corrosive environment and providing a firm adhesive between the metal surface and the rubber surface to be maintained over a long period of time (page 4 of translation paragraph 5 lines 7-9 and abstract).

In response to applicant's argument that Kurashiki teaches that its impossible to form the organosilane compound film on the surface of the metal fitting without the imposition of the anodic oxidation film between the metal surface and the organosilane compound film, applicant's claimed a damper using the comprising language which creates an open-ended limitation wherein other components may be added to the invention without disturbing the original intention of applicant's invention, therefore, the anodic oxidation film and the organosilane compound film can both be added to the Sievers for the purpose of being used under a corrosive environment and providing a firm adhesive between the metal surface and the rubber surface to be maintained over a long period of time (page 4 of translation paragraph 5 lines 7-9 and abstract).

In response to applicant's argument that Kurashiki provides no motivation, teaching or suggestion to provide a rough surface on the metal fittings to aid in

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restricting relative movement between the metal fittings and the rubber damping material or to aid in the adherence of the organosilane compound film to the metal fitting, Kurashiki teaches an organosilane provided between a metal and vulcanized and molded rubber for the purpose of being used under a corrosive environment *and* providing a firm adhesive between the metal surface and the rubber surface to be maintained over a long period of time (page 4 of translation paragraph 5 lines 7-9 and abstract). Therefore, even if the primary reference, Sievers, overcomes the problem of corrosion, Kurashiki still teaches the organosilane film to provide a firm adhesion between the metal surface and the rubber surface to be maintained over a long period of time.

Thus, in the absence of any evidence to the contrary, it remains the Examiner's position that the claimed invention is rendered obvious over the prior art of record discussed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
August 16, 2004
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NASSER AHMAD
PRIMARY EXAMINER
8/22/04